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09/751,609	12/28/2000	Marc Traylor	D-6904	8543

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EXAMINER

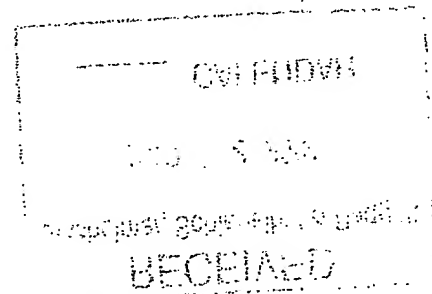
SZUMNY, JONATHAN A

ART UNIT PAPER NUMBER

3632

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/751,609
Filing Date: December 28, 2000
Appellant(s): TRAYLOR, MARC

Eric Whitesell
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 20, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,729,158

Nagy

4-1973

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy '158.

With respect to claims 1, 4, 7, 11-14, 18 and 19, Nagy '158 discloses a holder (figure 1) comprising a clamp (28, 30, 32, 33 and 34, figure 1), a magnet (48, figure 1), a magnet holder (40, 42, 44 and 46, figure 1) and a resilient member/length of resilient

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material/spring (figure 1) having a proximal portion (figure 1) attached to the clamp and a distal portion (figure 1) attached to the magnet; wherein the resilient member (24), the magnet holder (46) and at least a portion of the clamp (28, 30, 32, figure 2) constitute a single molded structure; wherein the holder further comprises a paint can (6) and a paintbrush (10); wherein the resilient member (24) inherently has a force constant which produces some displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that a paintbrush attached to the magnet does not slide off the magnet. Regarding claims 2, 5, 8 and 15, the member inherently acts as a spring whenever a force is applied perpendicularly to it. With respect to claims 3, 6, 9, 16, member 24 is inherently resilient due to the material it is made from.

Regarding claims 10, 17 and 20, Nagy '158 fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75 g. It would have been obvious to an ordinary artisan at the time the invention was made that the resilient member could be selected so as to limit acceleration of the paintbrush to any number of certain degrees, and any specific degree, including to no more than 0.75 g would clearly be a design choice (so as to satisfy specific user preferences) and hence is not considered patentable.

(11) Response to Argument

Issue 1

The appellant contends that the Examiner erred in alleging the leg (24) of Nagy '158 is equivalent to the claimed resilient member. Referring to lines 52-53 of column 1 of Nagy '158, it is clearly stated that the leg is "bendable". Hence, it is interpreted that the leg (24) is in fact resilient.

Continuing, the applicant alleges that the Examiner stated it would have been obvious to an ordinary artisan to "select the vertical leg (24) in Nagy to limit acceleration of the paintbrush" ("limiting acceleration of the paintbrush only being recited in dependent claims 10, 17 and 20). To begin, with respect to claims 1-9, 11-16, 18 and 19, the Examiner first indicated that the resilient member (23) inherently has a force constant which produces some displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that a paintbrush attached to the magnet does not slide off the magnet. Because the resilient member of Nagy '158 is "*bendable flat faced metal*" (column 1, lines 52-53), without a doubt, it has a force constant. As far as that force constant specifically being selected to produce a displacement of the distal portion when subjected to a shock *so that the paintbrush attached to the magnet does not slide off the magnet*, Nagy '158 also inherently suggests such a feature.

More specifically, for instance, in the invention of Nagy '158, when the paintbrush is attached to the magnet, there is obviously, clearly, and inherently *some* mechanical shock applied to the paintbrush, and there is obviously, clearly, and inherently *some* displacement of the distal portion upon the mechanical shock applied to the paintbrush,

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yet, the paintbrush obviously does not slide off the magnet, since, for instance, in figure 1 of Nagy '158, the paintbrush is in fact attached to the magnet. Therefore, Nagy '158 does in fact teach the resilient member to have some force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet. Further, acceleration of the paintbrush is inherently limited to *some* degree by the resilient member (24) since, as previously mentioned, the paintbrush is attached to the resilient member (24) in figure 1 of Nagy '158.

Continuing, on the bottom of page 4 of the Brief, the appellant states that since the vertical orientation of the member (24) is nearly parallel to the direction in which the paint can would be picked up or set down, most of the force between the brush and the can would act to apply compression or tension in the metal strap, and thus no displacement would occur that could reduce acceleration of the paintbrush. The Examiner surely disagrees. With reference to figure 2 of Nagy '158, the member (24) is clearly not perfectly vertical. Further, as previously mentioned, because the member (24) is clearly resilient, when the brush is attached to the holder, there must be *some* displacement of the distal portion of the member (24). The brush does *not* fall off during such displacement, and hence, acceleration of the brush must inherently be reduced.

Again, the applicant is making repeated allegations that the Examiner somehow modified the member (24) of Nagy '158 to be resilient and to produce a displacement of the distal portion of the member (24) and the paintbrush. The Examiner is making no

such modifications. Such features are inherently taught in Nagy '158 for previously described reasons.

Regarding the first full paragraph of page 5 of the Brief, the appellant contends that the Examiner failed to teach how the resilient member could be selected so as to limit acceleration of the paintbrush to any number of certain degrees so as to be performed with a reasonable expectation of success. As previously described, Nagy '158 already teaches a resilient member that produces a displacement of the paintbrush so as to prevent the brush from, for instance, sliding off the magnet and falling into the paint in the paint can. Hence, Nagy '158 already inherently teaches that the resilient member limits acceleration of the brush to *some* degree. Although claims 10, 17 and 20 do not specifically mention why a degree such as 0.75 g is selected, it is mentioned in the specification (bottom of page 7) that such a degree is selected so as to keep the brush on the magnet and prevent it from falling into the paint. The only difference in the Examiner's mind between Nagy '158 and the present invention is that Nagy '158 failed to *specifically* teach that the resilient member limit accelerations of the paintbrush to no more than 0.75 g. The applicant's reasoning for such a specific value is to accomplish a feature that Nagy '158 *already inherently teaches*. An ordinary artisan could easily select any number of resilient members that would limit acceleration of an object or paintbrush attached thereto to any number of various degrees, including 0.75g, and hence is not considered patentable.

Issue 2

The applicant contends that the force constant is not inherent in Nagy '158, and alleges that the Examiner essentially argued, "any displacement of the distal portion is sufficient to prevent the paintbrush from falling off the magnet." The applicant goes on to explain how such is not true, and then continues on page 6 of the Brief by describing the "rigid bracket" from the specification.

First off, the Examiner never recited, "any displacement... ..is sufficient to prevent the paintbrush from falling off the magnet." This is just not true. Quite possibly, if the paintbrush, holder and paint can were dropped off the 70th floor of the Sears Tower, the paintbrush would fall off the magnet. The Examiner merely stated that as shown in figure 1, the paintbrush is in fact attached to the magnet. While the brush is being attached, there must have been *some* displacement of the distal portion of the resilient member that obviously prevented the brush from falling into the paint in at least one instance.

Continuing, it is not known why the applicant is making reference to a "rigid bracket," nor why the applicant is referring to the member (24) as being a "rigid bracket." Nagy '158 *clearly* taught the member (24) to be *bendable*.

On the bottom of page 6 through the middle of page 8, the applicant quoted case law discussing a characteristic that "may" be present. There is no "may" with regards to Nagy '158. All features of the claims, with the exception of the 0.75g value of claims 10, 17 and 20, are explicitly or inherently taught.

Issue 3

The appellant contends that the Examiner erred on page 4 (assuming in the previous office action) in dismissing the selection of the claimed force constant as a design choice or user preference. The Examiner never dismissed the claimed force constant as a design choice or user preference. However, the Examiner did in fact dismiss the selection of the resilient member to limit acceleration of the brush to no more than 0.75g as a design choice or user preference.

Although Nagy '158 did not explicitly recognize the supposed need to mechanically isolate the brush and magnet from the can, as previously mentioned, Nagy '158 already has taught the member (24) to be resilient, and the mentioned displacement of the distal end of the member (24) *inherently* occurs while preventing the brush from falling off the member (see figure 1, the brush is in fact attached to the member 24).

On the top of page 10 of the Brief, the appellant contends that since Nagy does not disclose an arrangement of the vertical leg (24) that is perpendicular to the direction of force as alleged by the rejection, there is insufficient support to sustain the rejection of claims 1-20 under 35 U.S.C. 103. Absolutely none of the appellant's claims even mention the word "perpendicular". Hence, such a discussion has absolutely no bearing on the patentability of the claims.

The rest of page 10 repeats the discussion of member (24) being "rigid," which is not true, and discusses the supposed lack of Nagy '158 to teach the member (24) to

have a force constant, which is not true. Further, on the bottom of page 10, the appellant discusses the value of 0.75g that has already been addressed.

Issue 4

The appellant continues to allege that the Examiner modified Nagy '158 to have a selected force constant. Again, as repeated numerous times, Nagy '158 inherently teaches such a force constant, there is no modification. The Examiner did in fact show that the feature is inherent in Nagy '158.

Arguments Supporting Separate Patentability of Claims on appeal

On pages 11 and 12, the appellant alleges that the resilient member, magnet holder and at least a portion of the clamp do not constitute a single molded structure. Such is not true. The Examiner is referring to the magnet holder as member 46 (it inherently "holds" the magnet, without it the magnet could easily be disengaged), the resilient member as 24, and a portion of the clamp as 28, 30 and 32, generally. All three of these members constitute a "single molded structure." See figures 1 and 2 of Nagy '158.

It is interpreted that all other allegations and arguments have been addressed.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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February 24, 2004



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SUPERVISORY PATENT EXAMINER

February 24, 2004

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Summary

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site (www.USPTO.gov) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: http://www.uspto.gov/ebc/registration_pair.html.

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at eReference@uspto.gov or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

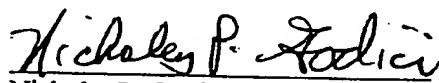
Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

Date: 12/1/03


Nicholas P. Godici
Commissioner for Patents